

Application Ser. No.: 10/664,835
Filing Date: September 22, 2003
Examiner: Nwaonicha, Chukwuma O.

Remarks

In the Office Action, the Examiner noted that claims 1-3 and 5 are pending in the application; and that claims 1-3 and 5 are rejected. The Examiner's rejections are respectfully traversed below.

Rejection Under 35 U.S.C. § 102(a)

Claims 1-3 stand rejected under 35 U.S.C. 102(a) as being anticipated by Kerdel et al. (Biochemical Society Transactions, 1978, 6(4), 785-787).

In particular, the Examiner alleges that "Kerdel et al. disclose applicants claimed compound (1-hydroxyindan-2-ylmercapturic acid), that is, when X is S, Y is O, R₁-R₄ are hydrogen, R₅ is CH₂CH(NHR₇)-COR₈, R₇ is C(O)C₁-alkyl and R₈ is OH. See page 786, scheme 1."

However, it is respectfully submitted that the Examiner has erred in his analysis. Claim 1, as amended by a preliminary amendment filed with the application on September 22, 2003 recites that "where in each case at least one of the radicals R1, R2, R3 and R4 is different from hydrogen." Please see page 7, lines 9 and 10 of the preliminary amendment. Thus, it is submitted that claim 1 as presented is not anticipated by Kerdel et al., because the compounds of the present invention can never have all of R1 to R4 to be hydrogen. Furthermore, claims 2 and 3 depend directly upon claim 1 and recite additional limitations. Accordingly, it is respectfully submitted that claims 1-3 fully satisfy the requirements of 35 U.S.C. § 102(a). Thus, withdrawal of rejection as to claims 1-3 is respectfully requested.

Double Patenting Rejection

Claims 1-3 and 5 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 8-12 and 15-18 of copending Application No. 10/981,045, which is now allowed.

Application Ser. No.: 10/664,855
Filing Date: September 22, 2003
Examiner: Nwaonicha, Chukwuma O.

Applicants submit herewith a terminal disclaimer and a statement that the undersigned is authorized to act on behalf of the assignee of record. Thus, withdrawal of rejection as to claims 1-3 and 5 is respectfully requested.

Conclusions

In view of the above Remarks, it is respectfully submitted that claims 1-3 and 5 are now in condition for allowance and the early issuance of this case is respectfully requested. In the event the Examiner wishes to contact the undersigned regarding any matter, please call (collect if necessary) the telephone number listed below.

Applicants believe there are no fees due for this Rule 111 Amendment. However, if the Examiner deems that fees are due, please charge these fees to Deposit Account No. 18-1982 for Aventis Pharmaceuticals Inc. Bridgewater, NJ. Please credit any overpayment to Deposit Account No. 18-1982.

Respectfully submitted,

August 2, 2005

Balaram Gupta

Balaram Gupta, Ph. D., J. D.

Registration No. 40,009
Attorney for Applicants

Encl.: Terminal Disclosure

Statement under 37 CFR 3.73(b)

Aventis Pharmaceuticals Inc.
Patent Department
Route #202-206 / P.O. Box 6800
MAIL CODE: BWD-303A
Bridgewater, NJ 08807-0800
Telephone: 908-231-3364
Telefax: 908-231-2626